

R E M A R K S

Careful review and examination of the subject application are noted and appreciated.

SUPPORT FOR CLAIM AMENDMENTS

Support for the amendments to the claims can be found in the drawings as originally filed, for example, FIGS. 1-4 and in the specification as originally filed, for example, on page 9, line 7 through page 11, line 18. As such, no new matter has been added.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

The rejection of claims 1-5, 7-12, 15-17, 19 and 21-23 under 35 U.S.C. §103(a) as being unpatentable over Bretschneider et al. '629 (hereinafter Bretschneider) in view of Sartore et al. '103 (hereinafter Sartore) has been obviated by appropriate amendment and should be withdrawn.

The rejection of claims 13, 14, 20 and 25 under 35 U.S.C. §103(a) as being unpatentable over Bretschneider in view of Meyn et al. '623 (hereinafter Meyn) has been obviated by appropriate amendment and should be withdrawn.

The rejection of claim 24 under 35 U.S.C. §103(a) as being unpatentable over Bretschneider in view of Meyn and in further view of Indekeu et al. '477 (hereinafter Indekeu) has been obviated by appropriate amendment and should be withdrawn.

Bretschneider is directed to a method and apparatus for automatically updating data files in a slide presentation program (Title). Sartore is directed to a bus interface system and method (Title). Meyn is directed to an intelligent display system presentation projection arrangement and method of using same (Title). Indekeu is directed to a method for sizing message characters for a display (Title).

In contrast to the cited references, the presently claimed invention (claim 1) provides an apparatus comprising (a) a housing having an upper surface, (b) a first button disposed in the upper surface and configured to generate a first instruction, (c) a first device (i) disposed within the housing and (ii) configured to generate one or more first control signals in response to the first instruction, where the first control signals **consist of signals dedicated to advancing through a plurality of slides** presented by an electronic presentation program and (d) a bus interface disposed within the housing and configured to (i) present the one or more first control signals and (ii) provide power to the first device. The first device is configured to operate according to a standard device driver provided in an operating system. The apparatus is configured to connect, **in addition to a mouse and a keyboard**, to a second device configured to run the electronic presentation program. Claim 16 includes similar limitations. Bretschneider and Sartore, alone or in combination, do not appear

to teach or suggest all the elements of the presently claimed invention. As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

Specifically, assuming, *arguendo*, the pointing device (or mouse) 42 of Bretschneider is similar to the presently claimed apparatus (as suggested in the last paragraph on page 2 in the Office Action and for which Applicant's representative does not necessarily agree), the combination of Bretschneider and Sartore does not teach or suggest an apparatus configured to connect, **in addition to a mouse and a keyboard**, to a second device configured to run the electronic presentation program, as presently claimed. Furthermore, the combination of Bretschneider and Sartore appears silent regarding a first device (i) disposed within the housing and (ii) configured to generate one or more first control signals in response to the first instruction, where the first control signals **consist of signals dedicated to advancing through a plurality of slides** presented by an electronic presentation program, as presently claimed.

In particular, the mouse 42 of Bretschneider is referred to as a pointing device (column 4, lines 44-46 Bretschneider). One skilled in the art would understand that a mouse or pointing device would necessarily include mechanical or optical elements for generating signals in response to the motion of the mouse 42. The

signals generated in response to the motion of the mouse 42 of Bretschneider would control a cursor of the personal computer 20 of Bretschneider. Therefore, Bretschneider does not teach or suggest a first device (i) disposed within the housing and (ii) configured to generate one or more first control signals in response to the first instruction, where the first control signals **consist of signals dedicated to advancing through a plurality of slides** presented by an electronic presentation program, as presently claimed.

Furthermore, Bretschneider is silent regarding a motivation or suggestion to modify the pointing device 42 of Bretschneider such that it generates one or more first control signals **consisting of signals dedicated to advancing through a plurality of slides** presented by an electronic presentation program in response to the first instruction, as presently claimed. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (MPEP §2142.01, citing *In re Mills*). Since Bretschneider is silent regarding the desirability of modifying the pointing device 42 to generate one or more first control signals **consisting of signals dedicated to advancing through a plurality of slides**, Bretschneider does not provide the necessary suggestion or motivation. As such, the

presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

Furthermore, modification of the pointing device 42 of Bretschneider to obtain the presently claimed invention would make the resulting modified device unsuitable for use as a mouse or pointing device for operating the personal computer 20 with the Microsoft Windows® environment in order to run the Microsoft PowerPoint® presentation disclosed by Bretschneider. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification (MPEP §2143.01, citing *In re Gordon*). It is well known that with the Microsoft Windows® environment a mouse is used to move a cursor in response to the mouse's motion. Modification of the pointing device 42 of Bretschneider to generate control signals **consisting of signals dedicated to advancing through a plurality of slides** presented by an electronic presentation program in response to the first instruction, as presently claimed, would make the pointing device unsuitable for the intended use. Therefore, there is no suggestion or motivation to make the proposed modification. As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

Furthermore, Bretschneider discloses using a mouse and keyboard with a Microsoft PowerPoint® presentation (see FIGS. 1 and

3 of Bretschneider). The specification points out that the present invention is directed to solving a problem that can occur when a mouse and a keyboard are used to control Microsoft PowerPoint® presentations. Specifically, the specification provides:

Inadvertently pressing the right mouse button or other keyboard keys can ruin the presentation by backing up, or worse, exiting the PowerPoint program entirely. Such an error can lead to a flurry of activity, where the presenter often must ask a member of the support staff (or worse the audience) for assistance in resuming the presentation. Such an interruption disrupts the presentation flow and embarrasses the presenter (page 1, line 19 through page 2, line 5 of the specification).

Furthermore, Bretschneider discloses that the buttons on the mouse 42 are used for activities other than advancing the slide presentation. For example, FIG. 3 illustrates that the mouse can be used to update the Microsoft PowerPoint® software. FIG. 5C of Bretschneider shows an exemplary slide where a click of the mouse button installs Microsoft Internet Explorer. Because the buttons of the mouse 42 of Bretschneider can be used to perform tasks other than advance the slide presentation, Bretschneider does not teach or suggest an apparatus comprising (a) a housing having an upper surface, (b) a first button disposed in the upper surface and configured to generate a first instruction and (c) a first device (i) disposed within the housing and (ii) configured to generate one or more first control signals in response to the first instruction, where the first control signals consist of signals dedicated to

advancing through a plurality of slides presented by an electronic presentation program in response to the first instruction, as presently claimed. Therefore, the combination of Bretschneider and Sartore do not teach or suggest every element of the presently claimed invention. As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

Claims 2-5, 7-12, 15-17, 19, 21-23, 26 and 27 depend, either directly or indirectly, from claims 1 or 16 which are believed to be allowable. As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

With respect to the rejection of claims 13, 14, 20 and 25, the combination of Bretschneider and Meyn do not teach each and every element of the presently claimed invention. Specifically, claims 13 and 14 depend, either directly or indirectly, from claim 1 and, therefore, include the limitation of claim 1 that the apparatus comprises a bus interface configured to provide power to the first device. The Office Action appears to take the position that Bretschneider does not show a bus interface configured to provide power to the device (see last two lines of page 2 through page 3, line 8 of the Office Action).¹ The Office Action relied on

¹ The Bretschneider reference replaced the Lin reference cited in the previous Office Action. However, the reference to Lin was not updated. See page 2 of paper no. 5 and page 2 of paper no. 9.

the Sartore reference in combination with Bretschneider to teach a bus interface configured to provide power to the first device, as presently claimed. However, the basis for the rejection of claims 13 and 14 does not include the Sartore reference. The Office Action does not state how Meyn cures the deficiency of Bretschneider (see page 6, lines 15-16 of the Office Action). Therefore, the Office Action fails to factually establish or provide a convincing line of reasoning why the combination of Bretschneider and Meyn teach or suggest **a bus interface configured to provide power to the first device**, as presently claimed. Therefore, the Office Action fails to meet the Office's burden of factually establishing that the combination of Bretschneider and Meyn teach or suggest each and every element of the presently claimed invention (MPEP §2142). As such, claims 13 and 14 are fully patentable over the cited references and the rejection should be withdrawn.

Furthermore, with respect to claim 14, assuming, *arguendo*, the status dialog of Meyn is similar to the presently claimed alert indicator (as suggested in lines 15-16, on page 6 of the Office Action and for which Applicant's representative does not necessarily agree), Meyn does not teach or suggest a visible indicator disposed in a surface of the housing, as presently claimed. In particular, the Office Action does not present any evidence or convincing line of reasoning why one of ordinary skill

in the art would consider the status dialogs of Meyn to be capable of being disposed in a surface of the mouse control device of Meyn or the mouse 42 of Bretschneider. Therefore, Bretschneider and Meyn, alone or in combination, do not teach or suggest all the elements of the presently pending claims 13 and 14. As such, the presently pending claims 13 and 14 are fully patentable over the cited references and the rejection should be withdrawn.

With respect to claim 20, Bretschneider does not appear to teach or suggest a device **consisting of** (a) a housing configured to be held in a hand of a presenter, (b) a first button and a second button disposed in a surface of the housing and (c) a control circuit (i) disposed within the housing and (ii) configured to generate one or more first control signals when the first button is pressed and one or more second control signals when the second button is pressed, where (i) the one or more first control signals and the one or more second control signals are **dedicated to controlling advancement through a plurality of slides** presented by an electronic presentation program and (ii) the control circuit is configured to communicate through a bus with a standard device driver provided in an operating system, as presently claimed.

Meyn does not cure the deficiencies of Bretschneider. Specifically, Meyn does not appear to teach or suggest a device **consisting of** (a) a housing configured to be held in a hand of a presenter, (b) a first button and a second button disposed in a

surface of the housing and (c) a control circuit (i) disposed within the housing and (ii) configured to generate one or more first control signals when the first button is pressed and one or more second control signals when the second button is pressed, where (i) the one or more first control signals and the one or more second control signals are **dedicated to controlling advancement through a plurality of slides** presented by an electronic presentation program, as presently claimed.

In particular, Meyn discloses a mouse control device (FIG. 3 and column 2, lines 55-56 of Meyn). Meyn states:

Navigating and entering commands, with the remote control device may be accomplished with relatively few keys. **The mouse disk and the Forward/Reverse keys. To select a button, checkbox, list box, or any item in a list box, the mouse disc is rotated to highlight the item. Once in a list box, Forward and Reverse are pressed to select an item. To click a button or check a checkbox (once selected), the mouse disc is pressed.** (column 13, lines 51-56 of Meyn, emphasis added).

Since the mouse disk and the Forward and Reverse keys of Meyn are used for "navigating and entering commands" and to select items in a list box, it follows that Meyn does not teach or suggest a device **consisting of** (a) a housing configured to be held in a hand of a presenter, (b) a first button and a second button disposed in a surface of the housing and (c) a control circuit (i) disposed within the housing and (ii) configured to generate one or more first control signals when the first button is pressed and one or

more second control signals when the second button is pressed, where (i) the one or more first control signals and the one or more second control signals are **dedicated to controlling advancement through a plurality of slides** presented by an electronic presentation program, as presently claimed. Therefore, the combination of Bretschneider and Meyn does not teach or suggest every element of the presently claimed invention.

Furthermore, Meyn is silent regarding the desirability of modifying the mouse control device in FIG. 3 of Meyn such that it **consists of** (a) a housing configured to be held in a hand of a presenter, (b) a first button and a second button disposed in a surface of the housing and (c) a control circuit (i) disposed within the housing and (ii) configured to generate one or more first control signals when the first button is pressed and one or more second control signals when the second button is pressed, where (i) the one or more first control signals and the one or more second control signals are **dedicated to controlling advancement through a plurality of slides** presented by an electronic presentation program, as presently claimed. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (MPEP §2142.01, citing *In re Mills*). Since Meyn is silent regarding the desirability of modifying the mouse control device to obtain the presently claimed

invention, Meyn does not provide the necessary suggestion or motivation. As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

Furthermore, modification of the mouse control device of Meyn to obtain the presently claimed invention would make the resulting modified device unsuitable for its intended purpose of navigating and entering commands as taught by Meyn. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification (MPEP §2143.01, citing *In re Gordon*). Modification of the mouse control device of Meyn to **consist of** (a) a housing configured to be held in a hand of a presenter, (b) a first button and a second button disposed in a surface of the housing and (c) a control circuit (i) disposed within the housing and (ii) configured to generate one or more first control signals when the first button is pressed and one or more second control signals when the second button is pressed, where (i) the one or more first control signals and the one or more second control signals are **dedicated to controlling advancement through a plurality of slides** presented by an electronic presentation program, as presently claimed, would make the mouse control device unsuitable for navigating and entering commands as taught by Meyn. Therefore, Meyn does not provide the necessary

suggestion or motivation to make the proposed modification. As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

Furthermore, Meyn discloses the mouse control device (or remote) has a mouse disk and numerous keys (see FIG. 3 and column 20, lines 2-49 of Meyn). The specification points out that the present invention is directed to avoiding the complexity and learning curve associated with devices like that taught by Meyn. Specifically, the specification provides:

Conventional approaches to minimizing errors during a presentation include accessory devices that have been designed and built to attempt to make delivery of an electronic slide show smooth and foolproof. An example of such a device includes wireless remote controls that use an infrared beam similar to a TV remote control. These devices usually attach to the PC through a serial port, and require special "driver" software to translate commands from the port to emulate keystroke or mouse commands that are recognizable by the presentation software. The driver software limits the use of such devices to pre-prepared computers, on which the driver software has been installed. In addition, these devices tend to be complex, to allow many options. Therefore they present a whole new set of "learning curve" challenges to the presenter, and thus may defeat the goal of being simple and foolproof (page 2, lines 6-19 of the specification).

Because the mouse control device of Meyn comprises (i) a mouse disk utilized for movement of the cursor throughout the projection display, (ii) a mouse disk button for cursor selection over a current position, (iii) a FWD key for moving the selection

"forward' within a contiguous logical group of items, (iv) a REV key for moving the selection "backward' within a contiguous logical group of items, (v) a System/Prog key utilized for a variety of purposes and (vi) a Pause/Return key which freezes a slide show, Meyn does not teach or suggest a device **consisting of** (a) a housing configured to be held in a hand of a presenter, (b) a first button and a second button disposed in a surface of the housing and (c) a control circuit (i) disposed within the housing and (ii) configured to generate one or more first control signals when the first button is pressed and one or more second control signals when the second button is pressed, where (i) the one or more first control signals and the one or more second control signals are **dedicated to controlling advancement through a plurality of slides** presented by an electronic presentation program, as presently claimed. Therefore, the combination of Bretschneider and Meyn do not teach or suggest every element of the presently claimed invention. As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

Claim 25 depends from claim 20 which is believed to be allowable. As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

With respect to claim 24, the Office Action fails to present particular findings as to the reason one skilled in the

art, with no knowledge of the claimed invention, would have selected the pager of Indekeu for combination with the mouse 42 of Bretschneider or the mouse control device of Meyn (see lines 1-6 on page 7 of the Office Action. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to use that which the inventor taught against its teacher (see *In re Lee*, 61 USPQ2D 1430, 1434 (Fed. Cir. 2002) citing *W.L. Gore v. Garlock, Inc.*, citation omitted). Therefore, the Office Action fails to meet the Office's burden of factually establish a *prima facie* case of obviousness (MPEP §2142). As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

Accordingly, the present application is in condition for allowance. Early and favorable action by the Examiner is respectfully solicited.

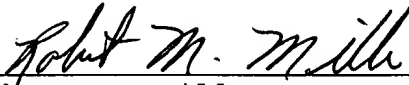
The Examiner is respectfully invited to call the Applicants' representative should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge our office

Account No. 50-0541.

Respectfully submitted,

CHRISTOPHER P. MAIORANA, P.C.



Robert M. Miller
Registration No. 42,892
24025 Greater Mack, Suite 200
St. Clair Shores, MI 48080
(586) 498-0670

Dated: February 5, 2004

Docket No.:0325.00281